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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 813,702	03 21 2001	Daniel J. DeFabio JR.	33900-DIV1	6209

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EXAMINER

FUREMAN, JARED

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 03 31 2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/813,702

Applicant(s)

DEFABIO, DANIEL J

Examiner

Jared J. Fureman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____

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DETAILED ACTION

Receipt is acknowledged of the IDS filed on 5/14/2001 and the revocation and substitution of power of attorney filed on 12/4/2002, which have been entered in the file.

It is acknowledged that this application is a DIV of U.S. Patent Application number

09/098,867, now U.S. Patent number 6,250,549, and now reexamination no.

90/006,172. Claims 1-9 are pending.

Claim Objections

1. Claim 5 is objected to because of the following informalities: Claim 5, line 1: "said storage medium" lacks proper antecedent basis. Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by "Chemical Heritage".

"Chemical Heritage" teaches an article (the book in the photograph on page 11) bearing an original signature of a selected individual (Mr. Gordon Cain), and an image of the individual signing the article (see the photograph on page 11).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schireck (US 5,306,049, cited by applicants) in view of Wahlberg (US 3,798,603).

Re claims 1-3: Schireck teaches a memorabilia kit (10) comprising: an article (12) bearing an original signature of a selected individual (in this example, a sports figure), and an image (26) of the individual, wherein the image is a real time image (in that the picture 26 was taken in real time), wherein the image is placed on a medium (card 14), wherein the medium and the article are separate pieces of the kit (see figure 1 and column 2 line 5 - column 3 line 5).

Schireck fails to specifically teach the image being an image of the individual signing the article.

Wahlberg teaches a system comprising: an image (generated via camera 537) of a selected individual (a purchaser) signing an article (tape 534), wherein the image is a real time image (in that the image is taken in real time) (see figures 2, 4, column 4 line 62 - column 5 line 21, column 5 lines 46-59, column 6 lines 8-13, column 9 lines 30-42, column 10 line 65 - column 11 line 5, column 12 lines 35 - 54, and column 14 lines 4-13).

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In view of Wahlberg's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the system as taught by Schireck, the image being an image of the individual signing the article, in order to provide the user with additional visual evidence of the authenticity of the signature and the article.

Re claims 1, 2, 4, and 9: Schireck teaches a memorabilia kit (10) comprising: an article (14) bearing an original signature of a selected individual (in this example, a sports figure), and an image (26) of the individual, wherein the image is a real time image (in that the picture 26 was taken in real time), wherein the article is a storage medium and the image is stored on the storage medium (the card 14 represents a storage medium in that it contains printed information, including the printed picture 26), wherein the article has identifying indicia (for example, a serial number) thereon, and wherein the indicia is also associated with the image (the serial number is associated with the image in that the image and serial number are both printed on the card 14) (see figure 1 and column 2 line 5 - column 3 line 5).

Schireck fails to specifically teach the image being an image of the individual signing the article.

The teachings of Wahlberg have been discussed above.

In view of Wahlberg's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the system as taught by Schireck, the image being an image of the individual signing the article, in order to

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provide the user with additional visual evidence of the authenticity of the signature and the article.

6. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schireck as modified by Wahlberg in view of Schlauch (US 6,082,774).

The teachings of Schireck as modified by Wahlberg have been discussed above.

Schireck as modified by Wahlberg fails to teach the storage medium further including an additional recording of the individual involved in an event other than signing of the article, the storage medium further including statistical data indicative of accomplishments of the individual.

Schlauch teaches an article (100) bearing an original signature (130) of a selected individual (a preferred personality) and a recording (image 193) of the individual involved in an event (in this example, a baseball game) other than signing of the article, the storage medium further including statistical data (recorded on reverse side 102 of article 100) indicative of accomplishments of the individual (see figures 1A, 1B and column 17 lines 10-18).

In view of Schlauch's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the system as taught by Schireck as modified by Wahlberg, the storage medium further including an additional recording of the individual involved in an event other than signing of the article, the storage medium further including statistical data indicative of accomplishments of the individual, in order to provide additional details of the individual, thereby increasing interest in the article.

7. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schireck as modified by Wahlberg in view of Ippolito (US 5,356,136).

The teachings of Schireck as modified by Wahlberg have been discussed above.

Schireck as modified by Wahlberg fails to teach a writing utensil, wherein the writing utensil is used in the signing of the signed article.

Ippolito teaches a memorabilia kit including an article (2) to be signed by a desired individual (for example, an athlete), a writing utensil (1), wherein the writing utensil is used in the signing of the article (see figure 1 and column 2 lines 15-35).

In view of Ippolito's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the system as taught by Schireck as modified by Wahlberg, a writing utensil, wherein the writing utensil is used in the signing of the signed article, in order to allow the signing pen and article to be stored together.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Nama (US 4,991,008) teaches a system and method for recording images of financial transactions (which would naturally include the signing of articles such as checks and receipts) and storing the images on a storage medium. Houston et al (US 2003/0046543 A1) and McWilliam et al (WO 01/88884 A1) both teach systems for authenticating signatures on memorabilia items, including recording an image of the individual signing the item. Yamamoto (JP 62-209785 A) teaches providing a photograph and a signature of an individual on a recording medium.

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[Http://coldwarartifact.com](http://coldwarartifact.com) and "Japan Surrenders" both show images of individuals signing articles.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jared J. Fureman whose telephone number is (703) 305-0424. The examiner can normally be reached on 7:00 am - 4:30 PM M-T, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Jared J. Fureman
Jared J. Fureman
March 21, 2003